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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,804

10/20/2008

Nathan Kane

TP15054USPCT

4853

27777 7590 11/30/2009  
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EXAMINER

WEISZ, DAVID G

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

11/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/599,804	<b>Applicant(s)</b> KANE ET AL.	
	<b>Examiner</b> DAVID WEISZ	<b>Art Unit</b> 1797	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Acknowledgement is made of amendment filed 7/27/09. Upon entering the amendment, the claims 39-43 are withdrawn as being drawn to a non-elected invention and claims 27 and 38 are amended.

The claims 27-38 are pending and presented for the examination.

### ***Response to Amendment***

2. In response to the amendment the examiner changes the grounds for rejections.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 27-28, 32-33, 35 and 37-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamura et al. (*International Journal of Pharmaceutics*, 2001) (Yamamura) in view of Duffield et al (US 2003/0131905) (Duffield).

Yamamura discloses a method for analysis of a solid material wherein a powder compressed into a tablet (3.2 Tableting) is exposed to radiation and the scattered radiation was analyzed via powder X-ray diffraction (3.3 X-ray diffraction (powder method)), at an incident angle of 0.5 degrees (3.3 X-ray diffraction (powder method)) (*claim 37*). The reference does not specifically the method of coring the solid plug prior to analyzing.

Duffield discloses a method of coring a sample into a compressed plug with a coring tool [0015]. The reference additionally discloses that the plug is extruded with a pin (Figure 6c) (*claim 27, 28, 32, 35, 38*). It would have been obvious to use the coring method of Duffield in the analysis method of Yamamura as it is a known method of coring the solid necessary for analysis via the Yamamura method. The references do not specifically disclose a micrometer for adjusting the pin, it is conventional to use such a device for adjusting pins of a micron scale (*claim 33*).

7. **Claims 29-30, 34 and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamura in view of Duffield, as applied to claims 27-28, 32-33, 35 and 37-38 above, further in view of Vann et al (US 7101510) (Vann).

Yamamura-Duffield to not specifically disclose a rack for storing the sample/coring tool.

Vann discloses a sample/core matrix system for analyzing samples via radiation absorption/emission using a diode laser, which can have a variety of including x-ray and IR spectra (col3/l21-31) (*claim 36*). Such a radiation emitter could be configured to work in conjunction with powder X-ray diffraction. The system of Vann comprises a rack and a plate (Figure 1), with a lifting and lowering mechanism for samples (Figures 7a and 8a) (*claim 29, 30 and 34*). The reference additionally discloses that such a system provides quick and accurate dispensing of multiple samples (col2/L15-19). It would

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have been obvious to one having ordinary skill in the art to use the system of Vann with the method of Yamamura-Duffield as it would provide quick and accurate management/analysis of multiple samples.

8. **Claim 31** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamura in view Duffieldm, further in view of Vann, as applied to claims 27-30 and 32-38 above, further in view of Maher et al (US 7312043) (Maher).

Regarding claim 31, Yamamura-Duffield-Vann do not specifically disclose the method wherein the top plate of the rack absorbs radiation.

Maher discloses properties of multiwell plates, which can have many optical properties including the absorbance of radiation for the prevention of cross talk and increase accuracy (*Col17/L55-66*) (*claim 31*). It would have been obvious to one having ordinary skill in the art to adjust the optical properties of the rack in Duffield-Vann because it prevents optical cross-talk and increases accuracy.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 27-38 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID WEISZ whose telephone number is (571)270-7073. The examiner can normally be reached on Monday - Thursday, 7:30 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571)272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/22/2009

/Yelena G. Gakh/  
Primary Examiner, Art Unit 1797

/D. W./

Examiner, Art Unit 1797